

## ***REMARKS***

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1- 16 are now pending in this application. Claims 1, 8, 12 and 16 are independent.

Reconsideration of this application is respectfully requested.

### ***Rejections under 35 USC 103(a)***

Claims 1-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable based upon various combinations of references, as addressed immediately below. These rejections are respectfully traversed.

Regarding claims 1-7, the Examiner admits that Jung et al. (U.S. Patent 6,441,401) lacks numerous structural features of the presently claimed invention. Next, the Examiner lists four references, which allegedly cure the deficiencies of Jung et al., namely "Song (4,902,638) further in view of Muto (4,902,638) further in view of Endo et al. (6,016,174) further in view of Kim et al. (6,429,909)."

### ***Analysis of the Rejections***

In each instance, the Examiner fails to provide any motivation to one of ordinary skill in the art to pick and choose structural features or method steps

from these various references in order to arrive at the presently claimed invention. Such motivations must be found in the prior art of record or established common knowledge to those of ordinary skill in the art. The motivation to combine references cannot be based upon hindsight obtained from a reading of the present invention.

Plainly, there is no suggestion to combine the disparate teachings of Song, Muto, Endo and Kim with those of Jung in the manner proposed by the Examiner. In the first place, the device of Jung already has a redundant repair line that overlaps and is insulated from the storage wire at one end to be shorted and repair an open wire defect (Jung, Col.1, line 65 –Col. 2, line 5). In consideration of the combination of elements disclosed in Jung, including the redundant repair line, neither reason nor need to modify stand out, Jung not disclosing a need for improvement of its device. In the second place, the Office Action fails to demonstrate, let alone even allege, that Jung has the problems that Song is designed to correct (see Jung, Col.2, lines 53-59 and Song, Col. 3, lines 1-6). In the third place, the Office Action fails to demonstrate that the Jung-Song reference combination has the problems that Muto is designed to correct. In the fourth place, the Office Action fails to demonstrate that the Jung-Song-Muto reference combination has the problems that the Endo reference is designed to correct. In the fifth place, the Office Action fails to demonstrate that the Jung-Song-Muto-Endo reference combination has the problems that the Kim reference is designed to correct. In the sixth place, the

Office Action fails to demonstrate that all of the proposed modifications of the base reference, Jung, would result in an efficient device well suited to operate at all, let alone in an efficient manner. In this regard, the Office Action is silent as to exactly how the plural proposed modifications of the base reference will take place and will not conflict with each other. More likely, the references provide a disincentive to one of ordinary skill in the art to make the proposed modifications, in that they would not result in a properly functioning device.

The Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and *In re Kamm*, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972), and obviousness cannot be established by locating references which describe various aspects of appellant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what appellants have done. *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993). Here we find no persuasive evidence of such a motivating force.

Moreover, in establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine

reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. Int. 1995). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Moreover, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1126, 1127 (Fed. Cir, 1984). The only suggestion for modifying the prior art reference system in the manner proposed by the Examiner resides in the hindsight afforded one who first viewed appellant's disclosure. This is not a proper basis for a conclusion of obviousness. See, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references,

standing alone, are not “evidence.” See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

In this particular case, the only reason presented for motivation a skilled worker to modify the base reference with four different references is “in order to have a liquid crystal display device with better performance.” This is exactly the type of broad general statements that are not “evidence” of proper motivation to combine references, and is definitely not a clear and particular reason contemplated in the *Dembiczak* case, cited above.

Further, See *In re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper). There is no cure-all phrase, like “in order to make a \_\_\_ with better performance,” which satisfies the requirement of the Examiner to explain a motivation to combine the references.

As such, it is respectfully submitted that these rejections fail to state a *prima facie* showing of obviousness and should be reconsidered and withdrawn.

### **Allowed Claims**

The Examiner has indicated that claims 8-16 are allowed. Applicant appreciates the Examiner’s early indication of allowable subject matter in this application.

## **CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Percy L. Square, Esq. (Reg. No. 51,084) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

Request for Reconsideration filed May 17, 2004  
Response to Office Action of January 16, 2004

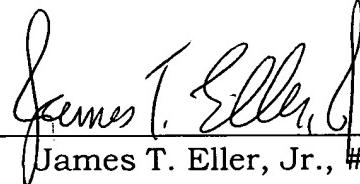
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If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASH & BIRCH, LLP

By \_\_\_\_\_



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